

FAX RECEIVED

OCT 31 17:23

GROUP 1600



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:	October ³⁰ 29 , 2002
FROM/ATTORNEY:	Michael J. Wise / Rebekka C. Noll
FIRM:	Perkins Coie LLP
PAGES, INCLUDING COVERSHEET:	2
PHONE NUMBER:	(310) 788-3399
TO EXAMINER:	CHUNDURU, Suryaprabha
ART UNIT:	1637
APPLICATION NUMBER:	09/804,700
FAX/TELECOPIER NUMBER:	(703) 308-2742 305-3014
PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED <u>ONLY</u> FOR RESPONSES TO RESTRICTIONS.	
COMMENTS:	

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 1096 OG-30, THE FILING DATED ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION. UNLESS THE DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

THE DOCUMENT(S) ACCOMPANYING THIS FACSIMILE TRANSMISSION CONTAIN(S) INFORMATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH IS CONFIDENTIAL AND/OR LEGALLY PRIVILEGED. THIS INFORMATION IS FOR THE USE OF THE INDIVIDUAL OR FIRM NAMED ON THIS SHEET. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISCLOSURE, COPYING, DISTRIBUTION, OR THE TAKING OF ANY ACTION IN RELIANCE ON THE CONTENTS OF THIS INFORMATION IS STRICTLY PROHIBITED, THE DOCUMENTS SHOULD BE RETURNED TO THE PATENT AND TRADEMARK OFFICE IMMEDIATELY. IF THIS FACSIMILE IS RECEIVED IN ERROR, PLEASE NOTIFY THE ATTORNEY LISTED HEREON IMMEDIATELY

Patent
54704.8025.US01 (266/176)

CERTIFICATE OF TRANSMITTAL

I hereby certify that this correspondence is being transmitted via facsimile to the United States Patent and Trademark Office at
(703) ~~308-2742~~ 305-3014, on:

Date: October 30, 2002

By: 

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: LADNER, Robert D. *et al.*
APPLICATION NO.: 09/804,700
FILED: March 13, 2001
FOR: URACIL DNA METABOLISM AS TARGET FOR
CHEMOTHERAPY: SCREENING ASSAYS AND
RELATED METHODS

EXAMINER: CHUNDURU,
SURYAPRABHA
ART UNIT: 1637

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

On October 2, 2002, the Examiner mailed a Restriction Requirement with a one-month reply date set for November 2, 2002. Applicants hereby submit a timely response.

The Office Action restricted the claims into three groups: Group I, directed to a method for determining whether a test compound induces uracil misincorporation into DNA; Group II, directed to a kit; and Group III, directed to a method for determining the effectiveness in a patient of chemotherapy. Applicants hereby elect to proceed with Group I (claims 1 – 10 drawn to a method for determining a test compound induces uracil misincorporation in to DNA). This election is made with traverse, as explained below.

The Commissioner is authorized to charge any fees required by the filing of these papers to Perkins Coie's Deposit Account No. 50-0665.

Traverse

The examiner has required restriction among the claims directed to a method for determining whether a test compound induces uracil misincorporation into DNA and the two single claims directed to a kit for determining whether a test compound induces uracil misincorporation into DNA and to a method for determining the effectiveness in a patient of chemotherapy targeting conversion of dUMP to TMP, respectively. While it is conceded that the inventions are distinct, applicants respectfully traverse the restriction requirement as applied to the method of claims 1-10 and the corresponding kit of claim 11, as well as the corresponding method of claim 12. As stated in MPEP 803, "if the search and examination of an entire application can be made **without serious burden**, the examiner must examine it on the merits, **even though it includes claims to independent or distinct inventions.**" Applicants respectfully submit that the method claims of Group I, the kit claim of Group II, and the method claim of Group III would not impose a severe burden on the process of examination. Patents containing claims to different methods, kits, and compositions are routinely granted without requiring restriction therebetween, as evidenced by the following patents:

Patent Number 6,469,058:

1. A **combination** of antineoplastic agents comprising an antitumor amount of acetyldinaline and an antitumor amount of gemcitabine, a pharmaceutically acceptable salt thereof, capecitabine, or cisplatin.
6. A **method** of treating cancer comprising administering to an animal in need of treatment an antitumor amount of a combination of claim 1.
11. A **kit** comprising acetyldinaline in one compartment and gemcitabine or a pharmaceutically acceptable salt thereof in a second compartment;

Patent Number 6,468,735:

1. A **method** of analyzing the angiogenesis modulating effect of a compound, comprising the steps of:
 - (a) incubating a sample that comprises of a fragment of porcine carotid artery with the compound;
 - (b) generating images of the sample; and
 - (c) quantitating the images to determine the extent of angiogenesis.
11. A **kit** for analyzing the angiogenesis modulating effect of a compound, comprising a fragment of porcine carotid artery in a medium with sufficient nutrients to allow growth of new vascular tissue;

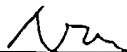
and Patent Number 6,465,620:

1. An *isolated polypeptide* comprising the amino acid sequence of SEQ ID NO: 4.
2. A *composition* comprising the polypeptide of claim 1 and a carrier.
3. A *kit* comprising the polypeptide of claim 1.
4. A *method for detecting* the polypeptide of SEQ ID NO:4 in a sample comprising:
 - a) contacting the sample with a compound that binds to and forms a complex with the polypeptide under conditions and for a period sufficient to form the complex; and
 - b) detecting formation of the complex, so that if a complex formation is detected, the polypeptide of SEQ ID NO:4 is detected.
5. A *method of producing* the polypeptide of SEQ ID NO:4, comprising:
 - a) culturing a host cell genetically engineered to contain a polynucleotide sequence encoding the polypeptide of SEQ ID NO:4 for a period of time sufficient to express the polypeptide in said cell; and
 - b) isolating the polypeptide from the cell culture or cells of step (a).

Applicants therefore respectfully seek reconsideration and withdrawal of the requirement with respect to the inventions of claims 1-10 and claim 11.

Respectfully submitted,
Perkins Coie LLP

Dated: 10/29/02

By: 
Rebekka C. Noll
Reg. No. 46,962



Perkins Coie LLP
Patent - LA
P.O. Box 1208
Seattle, WA 98111-1208
Phone: (310) 788-9900
Fax: (310) 788-3399